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### **REMARKS**

Applicants respectfully request reconsideration of this Patent Application, particularly in view of the above Amendment and the following remarks. No additional fee is required for this Amendment as the number of independent claims has not changed, and the total number of claims is less than previously filed.

#### **Claim Objections/Amendments**

Claims 24 and 36 have been amended to correct claim dependencies, thereby rendering the claim objection moot. This Amendment can and should be entered after a final rejection in that it is responding to a form issue identified by the Examiner and it reduces issues for appeal. No new matter has been added to the claims by this Amendment.

#### **Claim Rejections - 35 U.S.C. §103**

The rejection of Claims 1, 36, 40, and 41 under 35 U.S.C. §103(a) as being obvious over Schut et al., DE 10044771 (machine translation), in view of Ahern et al., GB 2159386, is respectfully traversed.

Schut et al. discloses narrow incisions 6 formed in the mouthpiece case 1 to create paper strips (which appear to be similar to the grooves/teeth discussed at page 8, second paragraph, of the Substitute Specification). The Office

Action agrees that Schut et al. does not disclose or suggest Applicants' deformed part recited in Claim 1 that is disposed at an end of the mouthpiece (1) within the cavity (4) of the envelope (2) and that comprises a portion of the end that extends across the second cavity (3) and contacts the opposing inner side wall of the second cavity (3), and where clearances are formed on sides of the deformed part (5) between the deformed part (5) and the inner side wall of the second cavity (3).

The Office Action applies Ahern et al. for disclosing Applicants' "portion of the end that extends across the second cavity (3) and contacts the opposing inner side wall of the second cavity (3), and where clearances are formed on sides of the deformed part (5) between the deformed part (5) and the inner side wall of the second cavity (3)." The Office Action alleges that Applicants' arrangement is disclosed by element 318 in Figs. 11 and 12.

In Figs. 11 and 12, Ahern et al. discloses two transverse slits 316 that provide a portion 318 that is displaced inwardly (page 4, lines 102-108). As shown in Fig. 12, the displaced portion 318 does not extend across the cavity and contact the opposing inner side wall of the second cavity. In this manner, Ahern et al. also does not provide the recited clearances as there is not portion extending across the cavity. Neither Ahern et al. nor the combination provides the limitations as alleged in the final Office Action. As the combination does not provide all claim limitations, a proper *prima facie* case of obviousness has not been put forth in the final Office Action.

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For at least these reasons, the rejection of Claims 1, 36, 40, and 41 should be withdrawn.

The rejection of Claims 21, 25, and 35 under 35 U.S.C. §103(a) as being unpatentable over Schut et al., DE 10044771, in view of Ahern et al., GB 2159386, and further in view of Labarre, U.S. Patent 905,715, is respectfully traversed.

As an initial note, Claim 25 is independent, and the rejection appears to reference the rejection of independent Claim 1, which contains different limitations from Claim 25. Clarification of the use of Schut et al. and Ahern et al. to reject Claim 25 is requested.

Labarre is applied for disclosing a perforated diaphragm. However, Labarre discloses a rigid perforated plate for a tobacco pipe. The Office Action alleges it would have been obvious to use the perforated plate in the paper cigarette of Shut et al., but no detail on how the perforated plate of the Labarre can be implemented in the paper cigarette of Shut et al. is provided.

The combination does not provide or suggest Applicants' "empty envelope (2) overlapping the empty mouthpiece (1) with an entire length, ... and a separating partition disposed at a position within the mouthpiece (1) that is also within the envelope." The Office Action applies a perforated plate from a different type of instrument, namely a pipe, but does not explain how it would have been

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obvious to place this partition at a position that is within both the mouthpiece and the envelope of Schut et al. The prior art of record, particularly U.S. Patent 2,542,612 used in the rejection below, applies perforated filters as attachments at the end of paper cigarettes. There is no basis in the prior art of record to place the perforated plate of the Labarre pipe at Applicants' recited position within both the mouthpiece and the envelope.

The combination does not provide all limitations of Claim 25, namely an "empty envelope (2) overlapping the empty mouthpiece (1) with an entire length, ... and a separating partition disposed at a position within the mouthpiece (1) that is also within the envelope." The invention of Claim 25 would not have been obvious over Schut et al. and Ahern et al., in view of the pipe plate of Labarre, and the rejection of Claims 25 and 35 should be withdrawn. Claim 21 is patentable for the same reasons discussed above for Claim 1.

Favorable reconsideration and withdrawal of this rejection are respectfully requested.

The rejection of Claims 21, 25, and 35 under 35 U.S.C. §103(a) as being obvious over Schut et al., DE 10044771 (machine translation), in view of Arneson, U.S. Patent 2,542,612, is respectfully traversed.

The Office Action alleges that Schut et al. discloses a perforated separating partition (although at paragraph 13, the Office Action states Schut et al.

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does not disclose a perforated partition), and that Arneson discloses various alternative filter bodies, including perforated plates and spiral filters.

The Office Action alleges that it would have been obvious in view of Arneson to use the perforated plate or spiral filter for the paper cigarette of Schut et al. However, there is no basis in the combination for one of ordinary skill in the art to construct a paper cigarette with the Arneson filters at a position within both the mouthpiece and the envelope, as required by Applicants. The Arneson filters are housed in a separate attachment at an end of the cigarette mouthpiece.

The combination does not provide or suggest Applicants' cigarette, with an "empty envelope (2) overlapping the empty mouthpiece (1) with an entire length, ... and a separating partition disposed at a position within the mouthpiece (1) that is also within the envelope." Applicants' recited partition structure that is within both the mouthpiece and the envelope is not obvious over the Arneson end attachment. Favorable reconsideration and withdrawal of this rejection are respectfully requested.

The rejection of Claims 24, 37, and 38 under 35 U.S.C. §103(a) as being unpatentable over Schut et al., DE 10044771, in view of Ahern et al., GB 2159386, and further in view of Labarre, U.S. Patent 905,715, is respectfully traversed. Claims 24, 37, and 38 are patentable for at least the same reasons discussed for the independent claims.


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### **Conclusion**

Applicants intend to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicants have not addressed or resolved in this response, the undersigned attorney requests a telephone interview with the Examiner.

Applicants sincerely believe that this Patent Application is now in condition for allowance and, thus, respectfully request early allowance.

Respectfully submitted,



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